

The examiner's rejections of claims 11-17 over the ACS reference considered alone or in view of Hong et al. are traversed. The ACS reference which was cited by the applicants at page 2 of their specification admittedly discloses the reaction of ethylene carbonate does not anticipate the applicants' claims which relate, in pertinent part, to a methyl analog of ethylene carbonate, an unsymmetric carbonate. Favorable reconsideration of the rejection under 35 USC 102 is solicited.

The cited prior art does not render the applicants' invention obvious because the applicants have discovered that the application of unsymmetric carbonates produce yields which is significantly superior to their symmetric counterparts which is contrary to what would have been expected.

As a consequence of the use of non-symmetric carbonates instead of ethylene carbonate as used in the reference, two different reaction products can be formed (cf. formula on page 8 of the specification). It was totally unexpected that the desired product I is formed with a selectivity of more than 90% whereas the undesired Ia is formed to less than 10%.

The unsymmetric carbonates IV are significantly less reactive than ethylene carbonate (a fact well known to the skilled man) and thus lower yields compared to the reference would have been expected. The actual results show the opposite. Whereas the ACS reference discloses yields of 79% whereas according to the inventive process yields of close to 90% are obtained, i.e. even higher yields than the reference discloses for ethylene carbonate.

The possibility to work in the absence of a solvent is an additionally significant advantage when using the process on a commercial scale, which was not foreseeable from the prior art.

The results as demonstrated in the applicants' examples are

unexpected and render the applicants' invention unobvious.

The examiner has relied upon the decision of the court in the case of In re Durden et al. 226 U.S.P.Q. 359. The applicants respectfully urge that this decision is not controlling in view of In re Ochiai et al. 37 USPQ2D 1127. As is abundantly clear from this decision, "when any applicant properly presents and argues suitable method claims, they should be examined in light of all....relevant factors, free from any presumed controlling effect of Durden" or any other precedent, citing In re Dillon 16 USPQ2d 1897. In the instant case the contended invention is an improved process for the preparation of O-(2-hydroxyalkyl) oximes. The process involves the application of unsymmetric carbonates and unexpectedly results in yields significantly superior to that obtained when symmetric carbonates are employed. The results achieved by the applicants are both unexpected and contrary to what chemists of ordinary skill would have expected in as much as the unsymmetric analogs are known to be less reactive generally than their symmetric counterparts. The examiner is relying on a per se rule drawn from In re Durden which is improper since no such rule exists (In re Ochiai et al., supra). It is incumbent upon the examiner to weigh the specific differences between the claimed invention - with all its limitations - and the prior art references (Graham v. John Deere Co., 148 USPQ 459 USC 1966).

In view of the foregoing remarks and the unexpected results, the applicants respectfully urge that the instantly claimed invention is patentable. Favorable reconsideration and allowance of the claims is solicited.

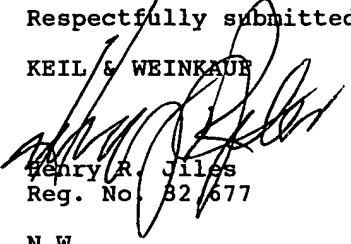
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Respectfully submitted,

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